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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,686	09/04/2001	Martha Torrey O' Connor	05222.00157	2969
29638	7590	08/31/2004		
BANNER & WITCOFF AND ATTORNEYS FOR ACCENTURE 10 S. WACKER DRIVE, 30TH FLOOR CHICAGO, IL 60606				
			EXAMINER CHRISTMAN, KATHLEEN M	
			ART UNIT 3713	PAPER NUMBER 7
DATE MAILED: 08/31/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/868,686

Applicant(s)

O' CONNOR ET AL.

Examiner

Kathleen M Christman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

1. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

Technological Arts Analysis:

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-9 recite an abstract idea. The recited steps of merely presenting information, determining a personality, integrating information, and monitoring progress and providing feedback so as to advance a student towards reaching a goal does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Claims 10-28 incorporate computer logic, memory and a processor. As such the claims, use, involve, and apply the technological arts.

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Useful, Concrete and Tangible Analysis:

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

In the present case, the claims do not produce a tangible result. For a claim to produce a tangible result there must be a reasonable or assured expectation of success. The claim limitation of "providing feedback that further motivates accomplishment of the goal tailored to a student's personality" is not a tangible result. There is no reasonable or assured expectation that the feedback will motivate the student to accomplish the goal. Although the attention of the feedback may be such, the expectation that this will occur does not exist.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble of the claims recite a system and method for creating a presentation, however the body of the claim does not result in the creation of presentation. The final step of the method results in monitoring and providing feedback to a student on their progress through what is presumably a presentation. The method and system appear to be directed towards a method and system for presenting a presentation instead of creating a presentation. Further the use of the term personality throughout the claims is unclear. In claim 1, personality appears to have its common art definition (ie the characteristics that distinguish a person). However, claim 3 recites that a student's personality is "indicative of praise" and claim 7 refers to having a personality a "number of times". Generally speaking the personality of an individual doesn't substantially happen a number of times, it is a set or almost set, combination of characteristics. The examiner has generally interpreted the term given its common and accepted

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meaning. Claims 3 and 7 (and their corresponding system claims) have been interpreted as a reference to the actions the user takes. For example claim 7 has been interpreted as the number of times a user incorrectly answers a question. Clarification on the definition of the term is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al (US 5727950). Cook et al teaches a method and system for the presentation of educational content including the steps and logic for: presenting information indicative of a goal (the instructional materials, col. 9: 55-58); determining a student's personality (the student data object, detailed description starting at col. 48: 18+); integrating information that motivates accomplishment of the goal tailored to the student's personality and monitoring progress toward the goal and providing feedback that further motivates accomplishment of the goal tailored to a student's personality (the adaptive agent based leaning system, see at least col. 6: 57-65, col. 12: 28-34, col. 28:29-59), as in **claims 1 and 10**. Determining a student's personality based upon a student's answers (**claims 2 and 11**) is shown in col. 27: 49-51. Providing praise (encouragement, rewards) for the student if the student's personality is indicative of praise (**claims 3 and 12**) is shown in col. 13: 21-28. Having the student repeat an exercise (**claims 4 and 13**) is shown in col. 27: 66 – col. 28: 12. Utilizing the selected personality to feed back the student's own work to the student (**claims 5 and 14**) is shown in Figure 4. Determining the student's personality by comparing answers to pre-stored answers indicative of known personalities (**claims 6 and 15**) is shown at col. 14: 5-

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63. Feedback based upon the number of times the student has a particular personality (claims 7 and 16) is shown in col. 6: 49-53. Personality determined based on interaction with an agent (claims 8 and 17) is shown in Figure 1, element 118, and described throughout the specification. Cook et al teaches the environment of the simulation being corporate which business scenarios (claims 9 and 18) in col. 9: 1-13.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. Ho et al (US 6120300)- reward based instruction based upon a student profile and adaptive teaching techniques.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Christman whose telephone number is (703) 308-6374. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kathleen M Christman
Examiner
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August 26th, 2004